

DOCKET NO: 283530US40PCT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
NAOHISA HIGASHIYAMA, ET AL. : EXAMINER: ROSATI, BRANDON M
SERIAL NO: 10/563,599 :
FILED: JANUARY 6, 2006 : GROUP ART UNIT: 3744
FOR: HEAT EXCHANGER :
:

RESPONSE TO ELECTION OF SPECIES REQUIREMENT

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

In response to the Election of Species Requirement stated in the Official Action dated November 25, 2009, Applicants provisionally elect Species A - drawn to details of the uninformalizing member, and identify Claims 1-15 as readable on the elected species.

Applicants respectfully traverse the outstanding election requirement for the following reasons.

First, the outstanding Office Action simply states that “[t]he species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, species lack the same or corresponding special technical features for the following reasons: The existence of an anticipatory reference demonstrating that one or more generic claims lack novelty establishes that the species do not relate to a single general inventive concept.” It is respectfully submitted that without further information, the aforementioned findings are believed to lack grounds upon which it can be evaluated whether in fact the required distinctness and reasons for insisting on election are established. Accordingly, it is

respectfully submitted that the PTO has not carried its burden of proof to establish distinctness.

Furthermore, MPEP §803 states the following:

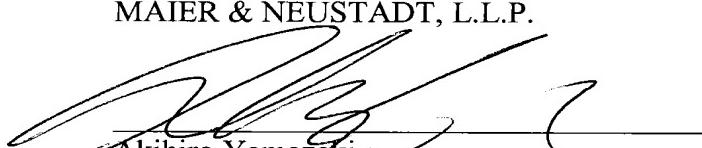
If the search and examination of all the claims in an application can be made without serious burden, the Examiner must examine them on the merits, even though they include claims to independent or distinct inventions.

In the present application, Claims 1-13 and 16-29 are directed to heat exchangers, Claims 14 and 30 are directed to refrigeration cycles including a heat exchanger, and Claims 15 and 31 are directed to vehicles having a refrigeration cycle including a heat exchanger. Hence, it appears that all the claims in the present application are part of an overlapping search area and that a search for Claims 1-15 would necessarily include a search directed to Claim 16-31 as well. It is therefore believed that there is no undue burden on the Examiner to search all claims under MPEP §803, and Applicants respectfully traverse the Election of Species Requirement on the grounds that a search and examination of all the claims in the present application would not place a *serious* burden on the Examiner.

Accordingly, it is respectfully requested that the requirement to elect a single disclosed species be withdrawn, and that a full examination on the merits of each of Claims 1-31 be conducted.

Respectfully submitted,

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